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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/567,872

05/19/2006

Ilia Fishbein

RCHP-135US

1203

23122 7590 02/05/2009
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EXAMINER

SHEN, WU CHENG WINSTON

ART UNIT

PAPER NUMBER

1632

MAIL DATE

DELIVERY MODE

02/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/567,872</p>	<p>Applicant(s) FISHBEIN ET AL.</p>	
	<p>Examiner WU-CHENG Winston SHEN</p>	<p>Art Unit 1632</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,8-10 and 33-38.
Claim(s) withdrawn from consideration: 2,4-6 and 11-32.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Thaian N. Ton/
Primary Examiner, Art Unit 1632

Continuation of 3. NOTE: The proposed amendments to cancel claim 38 and add new claim 39 raises new issues that would require further consideration and/or search for prior art..

Continuation of 11. does NOT place the application in condition for allowance because:

(i) Applicant's arguments have failed to overcome the rejection of claim 33 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention BECAUSE Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.

(ii) Applicant's arguments have failed to overcome the rejection of claims 1, 3, 8, 10, 33, and 38 rejected under 35 U.S.C. 102(b) as being anticipated by Halbreich et al. (U.S. patent No. 6,150,181, issued Nov. 21, 2000) BECAUSE Applicant's arguments rely on the proposed claim amendments (for claims 33 and 38), which have not been entered. The rejection is maintained of the record. Applicant's arguments that iron oxide is not a metal has been fully considered and found not persuasive because "A composition comprising a metal" recited in claim 1 encompasses the iron present in iron oxide. It is noted that the specification does not provide any particular definition for the word "metal" and the the open language "comprising" recited in claim 1 certainly indicate the possibility of the presence of components other than a pure metal element, which Applicant cited the definition from American Heritage Dictionary (See page 7 of Applicant's reply filed on 01/26/2009).

(iii) Applicant's arguments have failed to overcome the rejection of claims 1 and 8-10, 33, and 38 under 35 U.S.C. 102(b) as being anticipated by Feijen et al. (U.S. patent No. 4,634,762, issued Jan. 6, 1987). Applicant's arguments filed 08/20/2008 have been fully considered and they are not persuasive BECAUSE Applicant's arguments rely on the proposed claim amendments (for claims 33 and 38), which have not been entered. The rejection is maintained of the record.

Applicant argues that "surgical apparatus" taught by Feijen et al is not necessarily metal and Feijen et al. does not teach "modified protein is covalently bound to the metal surface".

In response, as cited in the rejection, Feijen et al. teaches extra-corporeal medical device includes a catheter (which is encompassed by claims 1, 8-9 of instant application) (See lines 24-38, column 4, Feijen et al.). Applicant does not provide any evidence that the catheter taught by Feijen is structurally different the catheter recited in claim 9 of instant application. Furthermore, Feijen et al. teaches conjugates for coating a surface of a medical device and the conjugates are covalently bonded conjugates of an anticoagulant and protein that are prepared in the presence of a coupling agent that forms amide linkages between the anticoagulant and the protein

(iv) Applicant's arguments have failed to overcome the rejection of claims 1, 8-10, 33, and 38 under 35 U.S.C. 102(e) as being anticipated by Kutryk et al. (U.S. patent No. 7,037,332, issued May 2, 2006, filed on 03/15/2001) BECAUSE Applicant's arguments rely on the proposed claim amendments (for claims 33 and 38), which have not been entered. The rejection is maintained of the record.

Applicant argues that the antibodies taught by Kutryk are not "modified proteins" and they are not attached to a metal surface even via a cross-linker. The antibodies are cross-linked to a matrix. (Kutryk Abstract, Col. 12, lines 15-23). The matrix is "coated" onto the medical device as described in Kutryk, Column 10, lines 15-29. "The stent is dipped or sprayed with a liquid solution of the matrix of moderate viscosity."

In response, claim 1 encompasses a modified protein is covalently bound to the metal surface either directly or indirectly.

(v) Applicant's arguments have failed to overcome the rejection of claims 1, 3, and 34 under 35 U.S.C. 103(a) as being unpatentable over Kutryk et al. (U.S. patent No. 7,037,332, issued May 2, 2006, filed on 03/15/2001) in view of Xu et al. (US patent 7,001,745, issued date 02/21/2006, filed on 09/30/1999) BECAUSE Applicant's have been fully considered and found not persuasive. The rejection is maintained of the record. Applicant's arguments and Examiner's response are the same as (iv).

(vi) Applicant's arguments have failed to overcome the rejection of claims 1, 33, and 35-37 under 35 U.S.C. 103(a) as being unpatentable over Kutryk et al. (U.S. patent No. 7,037,332, issued May 2, 2006, filed on 03/15/2001) in view of Li et al. (US patent 6,524, 572) BECAUSE Applicant's arguments rely on the proposed claim amendments (for claim 33), which have not been entered. The rejection is maintained of the record. Applicant's arguments and Examiner's response are the same as (iv).